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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|---|-------------|----------------------|---------------------|-------------------|
| 09/917,641  | 07/31/2001  | Yuji Shinohara       | 325772026100        | 1557              |
| 25227   | 7590        | 11/23/2005           | EXAMINER            |                   |
| MORRISON & FOERSTER LLP<br>1650 TYSONS BOULEVARD<br>SUITE 300<br>MCLEAN, VA 22102 |             |                      |                     | POLLACK, MELVIN H |
| ART UNIT  |             | PAPER NUMBER         |                     |                   |
|   |             | 2145                 |                     |                   |

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |   |                                      |
|------------------------------|---|--------------------------------------|
| <b>Office Action Summary</b> | Application No.                             | Applicant(s)                         |
|                              | 09/917,641<br>Examiner<br>Melvin H. Pollack | SHINOHARA ET AL.<br>Art Unit<br>2145 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 August 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12, 15 and 17-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12, 15 and 17-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 31 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: see attached office action.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/05 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-12, 15, and 17-19 have been considered but are moot in view of the new ground(s) of rejection.
3. The 112 rejections are withdrawn in light of the amendments and remarks submitted.
4. The 102 and 103 art rejections have been withdrawn in light of the newly added limitations in the claims. New art will be applied.

### ***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 11, 12, 15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (6,529,942), and further in view of Kohler (6,192,396).
8. For claims 1, 12, 15, 18, and 19, Gilbert teaches a data processing method and system (abstract; col. 1, line 1 – col. 2, line 30) comprising:
  - a. Accepting a keyword from a user (col. 7, lines 65 – col. 8, line 20; the keyword is the text-based embedded code used to tag text blocks);
  - b. Accepting identification of a document file from the user (col. 4, lines 57-60; the document is an e-mail message being generated);
  - c. Accepting a mail address from the user, the mail address corresponding to the accepted keyword (col. 5, lines 5-25; tags associated with email addresses);
  - d. Modifying data corresponding to the keyword, from the document file (col. 5, lines 50-55; col. 7, lines 45-65); and
  - e. Attaching the modified data to an e-mail message (col. 5, lines 25-45);
  - f. Wherein the user sends the e-mail message to the mail address (Fig. 2, #76).
9. Gilbert does not expressly disclose extracting data corresponding to the keyword, from the document file, or attaching the extracted data to an e-mail message. Kohler teaches a method and system (abstract) for creating recipient-specific e-mail messages (col. 1, line 1 – col. 2, line 67), the user generating and sending e-mails (col. 3, lines 63-65), in which documents are identified (col. 5, lines 10-20), and recipients identified (col. 5, line 65 – col. 6, line 20) such that data corresponding to keywords is not only modified but extracted such that only some recipients receive said contents (Fig. 10; col. 6, line 45 – col. 7, line 25; col. 8, lines 45-55). At the time the invention was made, one of ordinary skill in the art would have added Kohler extraction methods

to Gilbert in order to further Gilbert's goal of individualized messaging (Kohler, col. 1, lines 35-45) and to ensure Gilbert's further goal of ensuring that recipients better determine the messages meant for them (Gilbert, col. 1, lines 10-40).

10. Claim 17 is drawn to the limitations in claim 12. Claim 17 adds the limitations of a plurality of mail addresses and corresponding keywords, such that each recipient gets a different attachment. Gilbert teaches the limitation set (Fig. 6). Therefore, since claim 12 is rejected, claim 17 is also rejected for the reasons above.

11. For claim 2, Gilbert teaches that the data extracting step extracts data that includes the keyword, as the data corresponding to the keyword (Fig. 5).

12. For claim 3, Gilbert teaches that the data extracting step extracts a paragraph corresponding to the keyword, as the data corresponding to the keyword (Fig. 6).

13. For claim 4, Gilbert teaches that the document file is an HTML file, and the paragraph data is data that begins after a paragraph start tag and ends before a paragraph end tag (Fig. 5; col. 6, line 40 – col. 7, line 25).

14. For claim 11, Gilbert teaches that the e-mail message is an HTML-format message (Fig. 5).

15. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and Kohler as applied to claim 1 above, and further in view of Christensen et al. (6,347,320).

16. For claim 5, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a row corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches a method and system (abstract) of

searching within HTML files (col. 1, line 1 – col. 4, line 16) in which the included text may be between any two tags (col. 6, line 63 – col. 8, line 25), including within text paragraphs (Fig. 5) and within table row tags (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

17. For claim 6, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the row is data that begins after a table row start tag and ends before a table row end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

18. For claim 7, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a column corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

19. For claim 8, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the column is made up of one or more sets of data that each begin after a table data cell start tag and end before a table data cell end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

20. For claim 9, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a cell corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

21. For claim 10, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the cell is data that begins after a table data cell start tag and ends before a table data cell end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They disclose methods of text blocking, database e-mail methods, and other related background information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP  
10 November 2005

  
JASON CARON  
SIR AV 2145